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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,989	03/26/2004	David Hughes Horne	00179.0002	9603

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EXAMINER

ALANKO, ANITA KAREN

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,989

Applicant(s)

HORNE, DAVID HUGHES

Examiner

Anita K. Alanko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/26/04 filing of application.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

The use of the trademark or tradename "Super Corr B" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-3 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for using Super Corr B, does not reasonably provide enablement for any corrosion preventive compound. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification enables the use of Super Corr B as a corrosion preventive compound, but does not enable the use of any corrosion preventive compound (for example, as in US 5,089,227, Thompson et al, col.11 or simply a patterned mask that resists corrosion where the mask is in contact with the metal compared to openings in the mask where the metal can be etched and removed using corrosion). This is a scope of enablement rejection, since the claims are enabled for the invention as described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what the steps of the methods are since no manipulative steps are cited. For example, claim 1 is a statement of intended use “for minimizing”.

In claim 1, line 1, the term “minimizing” is a relative term that renders the metes and bounds of the claim unclear. Minimized compared to what? “Irregularities” is unclear- what comprises an irregularity? “Small radii” is a relative term – small compared to what? “Mitigate or prevent” is a relative term – mitigate compared to what? “Impaired flexibility” and “short fatigue life” are relative terms – impaired compared to what, short compared to what?

In claim 2, second line, “claim two” is unclear. “Mitigate or prevent” is a relative term. “Increased” is a relative term.

In claim 3, “mitigate or prevent” is a relative term. “Primarily during tension, shear, or compression” – it is unclear how this limits the claim, is it only during tension, shear, or compression – or can it also mitigate or prevent under other conditions? “Imperfections” is unclear- what comprises an imperfection? The terms “can contribute”, “may promote” “reducing”, “loss”, “restricted” and “short” are all terms that are unclear as to how they further limit the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Clerici et al (EP 976795 A2).

Clerici discloses a method comprising cleaning ([0020] – “hot alkaline cleaner” on steel bolts) and application of an etch ([0020] – pickling by 10% HCl) and surface treatment with a corrosion preventive compound ([0021]-[0023] – the “antifriction coating” which also provides corrosion resistance). Since the method of Clerici is the same as that cited, it is expected to be capable of providing the statements of intended use such as minimizing stress concentration points, minimizing stress intensity factor, and mitigate or prevent crack growth or propagation.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Lawrence (US 2002/0077004 A1).

Lawrence discloses a method comprising corrosion surface treatment with Super Corr B ([0009]), which is the same composition described in the instant specification, and therefore expected to produce the same results as in the instant invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 2000-338,685 A, JP 10-276,055 A, JP 58-224,178 A, GB 1,416,709 and the article from *Currents* are cited to show surface treatments using a corrosion preventive

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compound. Gabriel (US 5,462,892), DE 2447208 A, Lan et al (US 5,854,134), Chung et al (US 6,035,6891), Hensel et al (US 2,517,430), JP 2002-099,101 A, JP 08-276,533 A, JP 07-316,899 A and JP 05-211146 A are cited to show etching and corrosion preventive surface treatment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita K. Alanko whose telephone number is 571-272-1458. The examiner can normally be reached on Mon-Fri until 2:30 pm (Wed until 11:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571-272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anita K. Alanko
Anita K Alanko
Primary Examiner
Art Unit 1765